

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB      JAN. 5, 00

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re De Ster Corporation

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Serial Nos. 74/711,715;  
74/711,899 and 74/721,195

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Michael J. Powell of Kennedy, Davis & Hodge, LLP  
for De Ster Corporation.

Alan C. Atchison, Trademark Examining Attorney, Law Office  
102 (Thomas Shaw, Managing Attorney).

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Before Seeherman, Wendel and Bucher, Administrative  
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

De Ster Corporation has filed three applications for  
registration of the configuration of a container as a mark  
for "plastic containers for the storage of food."<sup>1</sup> The  
three configurations are depicted below:

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<sup>1</sup> Serial No. 74/711,715, filed August 7, 1995, claiming first use  
dates of September 1992; Serial No. 74/711,899, filed August 7,  
1995, claiming first use dates of March 1994; and Serial No.  
74/721,195, filed August 28, 1995, claiming first use dates of  
June 1993.

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4-Compartment Dinner Box  
Serial No. 74/711,715

3-Compartment Dinner Box  
Serial No. 74/711,899

2-Compartment Dinner Box  
Serial No. 74/721,195

Registration has been refused in each application on the ground that the configuration sought to be registered, although not de jure functional, is not inherently distinctive, and has not be shown to have acquired distinctiveness within the meaning of Section 2(f) of the Trademark Act.

Applicant and the Examining Attorney have filed briefs in each of the cases. No oral hearing was held, the initial request therefor having been withdrawn by applicant. Applicant's motion to consolidate the cases was granted by the Board on April 20, 1999 and accordingly, this one opinion is being issued for all three appeals.

The Examining Attorney initially refused registration on two grounds, both that the configurations appeared to be functional and that the configurations were not inherently distinctive and thus only registrable with an acceptable showing of acquired distinctiveness under Section 2(f). Upon the submission by applicant of evidence of numerous alternative designs for similar products, the Examining Attorney accepted applicant's argument that the configurations were not de jure functional and hence dropped the functionality refusal. The Examining Attorney maintained his position that the configurations were not inherently distinctive and, although applicant had submitted the declaration of an officer and other evidence in support of a claim of acquired distinctiveness, the Examining Attorney found this to be an insufficient showing to demonstrate acquired distinctiveness under Section 2(f). Applicant followed with supplemental evidence, which will be discussed infra, but the Examining Attorney continued

and made final his refusal on the basis of the insufficiency of the evidence to demonstrate acquired distinctiveness.

The Refusal

The Examining Attorney takes the position that applicant's food storage containers share many of the characteristics found in other available containers, as demonstrated by the evidence of alternative designs for similar containers submitted by applicant in response to the functionality refusal. (Exhibit C of applicant's response of August 6, 1996). He points out that many of the containers are rectangular in shape, are of sufficient depth to hold food, and feature separate compartments for different food items. While having earlier acknowledged that the shapes of some of the interior compartments of applicant's containers might be unusual, the Examining Attorney argues that there is nothing in the configurations as a whole which renders the designs unique or distinct from the containers of third parties. Thus, he maintains that the configurations are not inherently distinctive.

Applicant, however, has clearly stated in its reply brief that it makes no claim of inherent distinctiveness, and thus this issue need not be considered. Applicant's claim is that its dinner box configurations have acquired

distinctiveness because of certain features of the containers. Applicant argues that the particular angling and beveling of the compartments of its containers produce a unique and uncommon appearance, and that the "upscale" appearance and image of the containers as a whole sets them apart from the generic food packaging containers used by fast food establishments.

With respect to this claim of acquired distinctiveness, the Examining Attorney maintains that, in view of the similarity of the configurations of applicant's food containers in general to others used in the industry, the evidence submitted by applicant is insufficient to establish acquired distinctiveness under Section 2(f).

#### The Evidence

In each case, applicant has submitted the declaration of Daniel Whitehead, an officer of applicant, in support of its claim of distinctiveness. In his declarations, Mr. Whitehead states that applicant has sold its 4-compartment container since 1992, its 3-compartment container since 1994 and its 2-compartment container since 1993; that the purchasers of its dinner box containers are restaurants, delicatessens and similar stores engaged in selling foods of an "upscale" quality for take-home meals and that applicant's containers are designed to have a suitable

"upscale" appearance for these foods; that as a result of applicant's promotional and sales efforts and the distinctive appearance of the containers, applicant's designs have achieved fame in the industry and have come to be recognized as trademarks of applicant;<sup>2</sup> that since 1992 applicant has sold over 3.6 million boxes in all and expended over \$24,000 in promotional materials;<sup>3</sup> and that, upon becoming aware of the copying of these designs by a competitor Ultra Pac, Inc., applicant initiated a civil action, which has been settled, and Ultra Pac, Inc. has entered into a licensing agreement with applicant.

After the Examining Attorney found this evidence insufficient to demonstrate consumer recognition of the configurations of applicant's containers as an indication of source, applicant augmented its showing with eleven affidavits or statements from persons identified as customers or distributors of applicant describing the recognition of containers with applicant's "distinctive" configurations as symbols of, or as coming exclusively

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<sup>2</sup> The primary promotional or advertising material of applicant is its catalog, a copy of which was submitted with the declaration (Exhibit A).

<sup>3</sup> The original declaration was filed in 1996. In a supplemental declaration of Mr. Whitehead in 1997, these figures were updated to 9.5 million boxes in all and \$30,000 in promotional expenses. A further declaration with more recent figures which was attached

from, applicant. The persons making these statements were active in the food service industry in the marketing of consumer packaging products. While some persons gave direct statements with respect to their recognition of the configurations as originating from applicant, many expressed their beliefs that customers of theirs would recognize applicant as the source of the containers because of their "unique shape" or "lines that are unique and distinctive."

The Claim of Acquired Distinctiveness

The burden of proving acquired distinctiveness lies upon applicant. *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). Applicant argues it has met this burden by means of its evidence of 1) direct consumer testimony, 2) exclusivity, length and manner of use of its mark, 3) amount and manner of advertising, 4) amount of sales, 5) established place in the market, and 6) proof of intentional copying.

Looking first to the affidavits and statements which applicant has submitted as evidence of consumer recognition, we find the major deficiency with respect to

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to applicant's brief has been given no consideration. See Trademark Rule 2.142(d).

these statements lies in the fact that there is no evidence therein of recognition by the ultimate purchasers of the containers as an indication of source. Applicant has stated that its "upscale" containers are sold to restaurants, delicatessens and the like for the packaging of take-out meals. Thus, it is the owners of restaurants, delicatessens and the like who are the ultimate purchasers of the goods. There are no statements, however, from any purchasers at this level. Recognition of specific features of applicant's product line by distributors and others involved in the wholesale marketing of consumer packaging cannot serve to establish that the ultimate purchasers would recognize the so-called "upscale" features of applicant's containers as an indication that they originate from applicant. See *In re Edward Ski Products, Inc.*, 49 USPQ2d 2001 (TTAB 1999); *In re Pingel Enterprise Inc.*, 46 USPQ2d 1811 (TTAB 1988) and the cases cited therein.

Applicant argues that the statements of distributors should be considered evidence of purchaser recognition of applicant's configurations, citing the Board's holding in *In re Bose Corp.*, 216 USPQ 1001 (TTAB 1983), that the statement of a retailer as to recognition by purchasers of the product design as an indication of source is competent evidence of secondary meaning. We do not agree. In the

first place, the Board added the caveat in *Bose* that the weight to be given to this evidence is "of course ... a matter of judgment on the trier of the facts." *Supra* at 1005. Furthermore, in contrast to the *Bose* case, here we have no corroborative evidence that any particular design features have been promoted to the ultimate purchasers, such that they have reason to recognize the features as an indication of source. In fact, as pointed out by the Examining Attorney, it is not clear in most of the statements proffered by applicant what features even the declarants considered essential to the so-called "unique" and "distinctive" lines of applicant's containers.

Turning to the second category of evidence, we agree with the Examining Attorney that continuous use of these product configurations for periods ranging from five to seven years is insufficient in itself to demonstrate acquired distinctiveness. Furthermore, although applicant argues that its containers are highly visible products used by restaurants, delicatessens and stores to showcase food and that applicant has promoted the "upscale" quality of its containers for this purpose, there is no evidence of record of any such promotion or manner of use. The evidence is limited to the simple fact that applicant has manufactured and sold food containers having these

particular configurations for a period of five to seven years.

As for advertising, applicant has admitted that its expenditures for its printed advertisements have not been great, being only around \$30,000 in the period from 1992-1997. Although applicant argues that it also has expenditures for trade shows and in-person sales presentations, no evidence has been submitted to show the extent of these efforts, or the amounts of the expenditures.

Even more significantly, when we look to applicant's advertising material, we find no evidence of any promotion of the particular beveling and angling of the separate compartments or of the "upscale" quality of the containers as a whole. The only promotional material before us is applicant's catalog, which simply lists the dinner box items by name, color and dimensions and includes a rather indistinct photograph of each item. There is no further description and no promotion whatsoever of any particular features of the containers. There is no reference in this material to the design features being trademarks of applicant or a means of recognizing applicant as the source thereof. See *In re Visual Communications Company, Inc.*, 51 USPQ2d 1141 (TTAB 1999). Although applicant contends that

it is through direct touting by sales representatives that applicant promotes the distinctiveness of the product configurations, we have no evidence before us to support, or by which we can evaluate, this type of sales promotion.

Applicant's sales figures are more impressive in volume, but equally ineffective in demonstrating acquired distinctiveness for the container configurations. Although these figures may demonstrate the growing popularity of the containers, sales success is not, in itself, probative of purchaser recognition of the specific design or configuration of the containers as an indication of source. Desirability of the product, whether based on the overall configuration or particular features of the compartments, cannot be equated with acquired distinctiveness for the configuration as a trademark. See *In re Edward Ski Products, Inc.*, *supra*; *In re Pingel Enterprise Inc.*, *supra*; *In re E S Robbins Corp.*, 30 USPQ2d 1540 (TTAB 1992).

Finally, applicant places great importance on its civil action against its competitor Ultra Pac, Inc., both as evidence of the intentional copying of applicant's configurations and of applicant's securing its place in the market by litigating the issue. Applicant states that Ultra Pac, Inc. made virtually identical copies of applicant's dinner box containers to trade off the good

will of these designs, but, as a result of the suit, has acknowledged applicant's trademark rights in the configurations and has agreed to become a royalty-paying licensee in order to continue producing the containers.

Applicant has submitted a copy of the judgment dismissing the civil action by reason of settlement. In this consent judgment, the parties agreed that applicant has enforceable trademark rights in its consumer packaging products, which include both the dinner box products involved here and an 8-sided box. The terms of the license agreement between the parties with respect to these packaging products are set forth in a separate settlement agreement, a copy of which has not been made of record.

We have no evidence, however, to substantiate that Ultra Pac, Inc.'s intent in copying applicant's configurations was for purposes of attempting to trade on any secondary meaning which the configurations may have acquired as an indication of applicant as the source, rather than simply for the desirable qualities of certain features. See *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 36 USPQ2d 1065 (7<sup>th</sup> Cir. 1995). The fact that Ultra Pac, Inc. has agreed to a license for the production of containers of these particular configurations does not convince us that the configurations function as trademarks

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for applicant. As noted by the Examining Attorney, agreement by a competitor to take a license from applicant may well be viewed as a desire to avoid litigation and not as evidence that the configurations actually have acquired distinctiveness and point uniquely to applicant. See *In re Wella Corp.*, 635 F.2d 845, 196 USPQ 7, n.2 (CCPA 1977); *In re Consolidated Cigar Corp.*, 13 USPQ2d 1481 (TTAB 1989).

Accordingly, upon consideration of all of the evidence submitted by applicant, we find that applicant has failed to establish that the configurations sought to be registered as trademarks have acquired distinctiveness within the meaning of Section 2(f).

Decision: The refusal to register under Section 2(f) is affirmed in each application.

E. J. Seeherman

H. R. Wendel

D. E. Bucher

Trademark Administrative Judges,  
Trademark Trial and Appeal Board

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